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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,411	05/11/2005	Michio Tsuyumoto	3273-0202PUS1	4477

2292 7590 06/12/2009

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EXAMINER	
DESAI, ANISH P	

ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
06/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/534,411	TSUYUMOTO ET AL.	
	Examiner	Art Unit	
	ANISH DESAI	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *1-3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments in response to the Office action dated 03/11/09 have been fully considered.

2. In view of applicant's amendment and response, the 35 USC Section 102(b)/103(a) rejections based on Patel et al. (US 2001/0023014A1) are withdrawn.

3. A new 35 USC Section 112-first paragraph rejection is made.

International Search Report (ISR)

4. Applicant has provided the ISR on 05/11/05 citing several documents that are labeled as "X". The Examiner has reviewed these documents but not agreed with the citation of the ISR for the reasons given below. These documents are following:

(1) WO 01/19906A1 (US Patent 7,407,702 to Ohno et al. is equivalent) does not teach or suggest "wherein a maximum surface pore size…in the range of 0.7 to 1.5" and Gurley permeability and as claimed.

(2) JP 09-208736A (US Patent 5,856,426 to Takahashi et al. is equivalent) does not teach or suggest wherein a maximum surface pore size…in the range of 0.7 to 1.5" and Gurley permeability and as claimed.

(3) JP 2002-37905 does not teach or suggest the Gurley permeability, maximum surface pore size, and average inside porosity as claimed.

(4) JP 2002-086476 does not teach or suggest the Gurley permeability and "wherein a maximum surface pore size is 15…the average inside porosity D…in the range of 0.7 to 1.5." as claimed.

(5) JP 2000-260413A does not teach or suggest the Gurley permeability and "wherein a maximum surface pore size is 15…the average inside porosity D…in the range of 0.7 to 1.5." as claimed.

(6) JP 02-043911 does not teach or suggest Gurley permeability, "wherein a maximum surface pore size is 15…the average inside porosity D…in the range of 0.7 to 1.5.", and "wherein a polymer component forming the film comprises…acetate" as claimed.

(7) JP 2003-313356 A does not teach or suggest "wherein a maximum surface pore size is 15…the average inside porosity D…in the range of 0.7 to 1.5".

(8) JP 2003-26849A does not teach or suggest "wherein a maximum surface pore size is...in the range of 0.7 to 1.5" and the Gurley permeability as claimed.

(9) JP 09-169867 A does not teach or suggest wherein a maximum surface pore size is...in the range of 0.7 to 1.5" and the Gurley permeability as claimed.

(10) JP 05-148383 A does not teach or suggest "wherein a maximum surface pore size is 15…the average inside porosity D…in the range of 0.7 to 1.5" as claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 4-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. It is noted that applicant has made extensive amendments to claims. While the Examiner appreciates applicant's effort in pointing out where the support for the amendments is found in the specification, the Examiner respectfully disagrees with applicant. It is submitted that specification fails to provide the support for many of the newly added amendment.

(A) With respect to the newly added claim limitation "average surface pore size A of 0.7 to 10 μm" and "an average pore size A^1 of 0.7 to 10 μm at one surface, an average pore size A^2 of 0.7 to 10 at the other surface", while there is the support to recite that the "average surface pore size A^1 of 0.1 to 10 μm", there is no support to recite the range of the average surface pore size of 0.7 to 10 μm. While the Table 1-1 in the specification show the lower end of the claimed range (i.e. 0.7 μm), the Examiner submits that this is one data point that is specific to a particular example (e.g. Ex. 2). As such the Examiner suggests replacing "0.7 to 10 μm" with "0.1 to 10 μm". These limitations are found in claims 4-5 and 10-11.

(B) Regarding the newly added limitation "an average surface porosity C of from 50% to 80%", while there is the support to recite the average surface porosity of "48% or more (e.g. 48% to 80%) and preferably from about 60% to about 80%", there is no support to recite "an average surface porosity C of from 50% to 80%". Additionally, on page 8 of

applicant's amendment, applicant has stated that aforementioned limitation is supported at Table 1-1 at page 30 and lines 5-8 on page 12. The Examiner respectfully disagrees, because Table 1-1 shows only individual data point with respect to the porosity and there is no support to recite the entire range of porosity as claimed in Table 1-1 and on page 12 lines 5-8 as asserted by applicant. These limitations are found in claims 4-5 and 10-11.

(C) With respect to the newly added limitation "a maximum inside pore size is 5.1 μm or less", the Examiner submits that there is no support to recite said limitation. While Table 1-1 show individual data points representing the maximum pore Size, there is no support to recite the broad claim limitation of "a maximum inside pore size is 5.1 μm or less" since said limitations would encompass values such as 0.1, 0.15, 0.17 μm etc. for which for which there is no support. These limitations are found in claims 4-5.

(D) With respect to the newly added limitation "the average surface porosity C has an average porosity C^1 of from 50% to 80% at one surface and an average porosity C^2 of from 50% to 80% at the other surface", contrary to applicant's assertion, Table 1-1 and page 12 lines 5-8 of the specification fails to provide the support for said limitation. While there is the support to recite "the average surface porosity of "48% or more (e.g. 48% to 80%) and preferably from about 60% to about 80%", there is no support to recite the aforementioned limitation. These limitations are found in claims 4-5 and 10-11.

(E) Regarding the newly added limitation "the ratio C^1/D of C^1 to D is in the range of 0.7 to 1.5 and the ratio C^2/D of C^2 to D is in the range of 0.7 to 1.5", contrary to applicant's assertion the collective disclosure on page 4 lines 10-11 and lines 17-19 in the specification does not provide the support for the aforementioned limitation. While there is support to recite C/D of 0.7-1.5, there is no support for C^1/D and C^2/D each being 0.7-1.5. These limitations are found in claims 4-5.

(F) As to the newly added limitation "average inside pore size B is from 0.5 to 16.7 μm", the Examiner submits that contrary to applicant's assertion on page 9 of the amendment, there is no support to recite the aforementioned claim limitation. Specifically, applicant's calculation to calculate the pore size B is based on the assertion that the average pore size A is 0.7 to 10 μm, which is not supported by the specification as originally filled. These limitations are found in claims 10-11.

(G) Additionally, there is no support for the porosity values as recited in newly added claims 12-19. While there is support to recite D/D of 60-80%, there is no support to recite range of 70-80% and no support to recite that C^1 and C^2 are each 60-80% or 70-80%.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 4, 5, 10 and 11 recite "large" number of continuous micropores. The term "large" is a relative term as such it is not clear as to what is meant by "large" number.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Machine translation of JP 2002-37905, JP 09-169867, and JP 05-148383 attached. All are related to porous films.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794